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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,718	03/21/2001	Paul Schimmel	TSRI 817.0	3346

7590 07/02/2002

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EXAMINER

NICKOL, GARY B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/813,718

Applicant(s)

SCHIMMEL ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *fax cover sheet*.

### **DETAILED ACTION**

Claims 1-48 are pending in the application and are currently under prosecution.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is accepting a Fax Response for Written Restriction Requirements. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 36-37, drawn to isolated polypeptides and compositions thereof, classified in class 530, subclass 350.
- II. Claims 9-14, 16-17, drawn to isolated nucleic acid molecules, recombinant vectors, host cells, and methods of making a polypeptide, classified in class 536, subclass 23.5; class 435, subclasses 69.1, 320.1, and 325.
- III. Claim 15, drawn to an isolated antibody, classified in class 530, subclass 387.1.
- IV. Claims 18-19, drawn to a process for producing a polypeptide comprising treating the polypeptide with a protease, classified in class 435, subclass 23.

- V. Claims 20-26, 38 drawn to an isolated polypeptide having chemokine activity and compositions thereof, classified in class 530, subclass 300+.
- VI. Claims 27-29, 31-32, drawn to nucleic acids, recombinant vectors, host cells, classified in class 536, subclass 23.1; class 435, subclasses 320.1, 325, 69.1.
- VII. Claim 30, drawn to an isolated antibody, classified in class 530, subclass 387.1.
- VIII. Claim 33, drawn to a process for producing a polypeptide comprising treating with a protease, classified in class 435, subclass 23.
- IX. Claims 34-35, drawn to method and use of a pharmaceutical composition suitable for administration purposes, classified in class 514, subclass 2.
- X. Claims 39-46, drawn to methods of treating a condition that would benefit from decreased angiogenesis comprising administering a polypeptide to a human, classified in class 424, subclass 184.1.
- XI. Claim 47, drawn to a method of diagnosing a pathological condition comprising determining the presence or absence of a polynucleotide mutation, classified in class 435, subclass 6.

- XII. Claim 48, drawn to a method of diagnosing a pathological condition comprising determining the presence or amount of expression of a polypeptide, classified in class 435, subclasses 4, 7.1.

The inventions are distinct, each from the other because of the following reasons:

The Inventions of Groups I-III and V-VII represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects. For example, the polypeptides of Group I, which comprise a Rossman fold nucleotide binding domain, are materially distinct from the polypeptides of Group II, which comprise polypeptides with chemokine activity.

The inventions of Groups IV, and VIII-XII are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

The invention of Group I and the methods of Group X and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the polypeptide product as claimed can be used in a materially different process such as affinity chromatography.

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The invention of Group II and the method of Group XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (I) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the polynucleotide product as claimed can be used in a materially different process such as affinity chromatography.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.  
Examiner  
Art Unit 1642

GBN  
June 28, 2002

